

REMARKS

This submission is in response to the Official Action dated January 14, 2002. Reconsideration of the above identified application, in view of the following remarks, is respectfully requested.

Restriction Requirement

The Examiner has required restriction to one of the following Groups under 35 U.S.C. § 121:

Group I: Claims 1-3, 5-20, 50-65, drawn to an implant (class 623, subclass 11);
Group II: Claims 22-34, 36-49, 66-88, drawn to a method of augmenting soft tissue (class 128, subclass 898).

In the Office Action, the Examiner contends that the inventions are distinct because allegedly "(i) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product."

The Applicant hereby elects, with traverse, to prosecute the claims of Group I (Claims 1-3, 5-20, 50-65) which are directed to an implant. Although Applicant is making the above election to be fully responsive to the Restriction Requirement, Applicant respectfully traverses the Requirement and reserves the right

to petition under 37 C.F.R. § 1.144. In particular, applicant respectfully requests reconsideration and withdrawal of the Restriction Requirement to allow prosecution of
claim groups I and II in the present application, for the reasons provided below.

According to Patent Office examining procedures, "[i]f the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions" (MPEP 803). In this case, the search was already performed on the invention as a whole, and the claims were already considered collectively by a previous Examiner. In addition, a personal interview was conducted with the previous Examiner at the U.S. Patent and Trademark Office. The inventor went to the time and expense of attending this interview. To require a restriction requirement, at this late point in time, is prejudicial to the inventor and calls into question the judgment of the first Examiner.

Applicant respectfully submits that claim groups I and II as designated by the Examiner do not warrant separate examination and search. Both claim groups call for soft tissue implant material. Thus, it would be expected that any additional search and examination of claim groups I and II can be made jointly without increasing the burden on the Examiner. Applicant therefore respectfully requests examination of both claim groups I and II in this application.

Claims of Group II Should Be Rejoined

The applicant reserves his right to rejoinder of the non-elected claims prior to a notice of allowance for the elected claims of group I to the product in accordance with the guidance given by the Commissioner of Patents and Trademarks in 1184 OG 86. See *In re Ochiai*, 37 USPQ2d 1127 (Fed. Cir. 1995) and *In re Brouwer*, 37 USPQ2d 1663 (Fed. Cir. 1996). See also MPEP 821.04, which states,

Where product and process claims drawn to independent and distinct inventions are presented in the same application, applicant may be called upon under 35 U.S.C. 121 to elect claims to either the product or process. See MPEP Section 806.05(f) and Section 806.05(h). The claims to the nonelected invention will be withdrawn from further consideration under 37 C.F.R. 1.142. See MPEP Section 809.02(c) and Section 821 through Section 821.03. However, if applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims which depend from or otherwise include all the limitations of the allowable product claim will be rejoined.

It is apparent that the withdrawn process claims include all the limitations of the elected product claims, and, thus, if the product claims are found allowable, rejoinder should be permitted prior to a notice of allowance. In view of these considerations, the non-elected claims are not cancelled.

Therefore, in view of the above remarks, it is respectfully requested that the application be reconsidered and that all pending claims be examined on the merits.

Applicant(s): Arthur ASHMAN
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Examiner: D. Isabella

If there are any other issues remaining which the Examiner believes could be resolved through either a Supplemental Response or an Examiner's Amendment, the Examiner is respectfully requested to contact the undersigned at the telephone number indicated below.

Respectfully submitted,



Melvin C. Garner
Reg. No. 26,272
Attorney for Applicants

DARBY & DARBY, P.C.
805 Third Avenue
New York, N.Y. 10022
Phone (212) 527-7700